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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/347,690	07/02/1999	MANPREET S. KHAIRA	884.107US1	4194

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EXAMINER

CRAIG, DWIN M

ART UNIT	PAPER NUMBER
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2123

DATE MAILED: 05/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/347,690

Applicant(s)

KHAIRA ET AL.

Examiner

Dwin M Craig

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 24-28 is/are allowed.
- 6) ☒ Claim(s) 1, 2, 10, 14, 16-18 and 21 is/are rejected.
- 7) ☒ Claim(s) 3-9, 11-13, 15, 19, 20, 22 and 23 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

1. Claims 1-28 have been presented for reconsideration in view of Applicants amended claim language and arguments.

### Response to Arguments

2. Applicant's arguments filed on 2-26-2004 have been fully considered. Examiners response is as follows:

2.1 Regarding Applicants response to the 35 U.S.C. 101 rejection of Independent Claim 28:

Applicant has amended the claim language so that it is directed towards statutory subject matter, the Examiner withdraws the earlier 35 U.S.C. 101 rejections of that claim.

2.2 Regarding Applicants response to the 35 U.S.C. 103 rejections of Claims 1, 10, 14, 16-18, 21, 24 and 28:

Applicants have argued:

**The References Do Not Teach All Claim Limitations.** It is admitted in the Office Action that Rezek does not "disclose partitioning the latches into a plurality of partitions or maintaining a load balance within the plurality of partitions." It should also be noted that Rezek does not teach the fundamental concept of an "extended latch boundary component" (ELBC), its use, and/or manipulation, as claimed by the Applicants. The Application states: An elementary latch boundary component contains a single output and no internal latches. An extended latch boundary component, in one embodiment, is formed by clustering elementary latch boundary components, and in contrast with an elementary latch boundary component, an extended latch boundary component may contain an internal latch. In one embodiment, extended latch boundary component 103 includes latches 112 and 115 and primary inputs 118 and 121. Extended latch boundary component 109 includes latch 124 and inverter 127. In an alternate embodiment, an extended latch boundary component is formed by selecting a path having a first node that is either a latch or a primary output, a second node that is either a latch or a primary input, and a latch between the first node and the second node. Application, pg. 3, lines 4-13.

As a matter of distinction, the passages and figures of Rezek cited in the Office Action illustrate what is needed to provide qualified clock signals between modules to correctly optimize multi-cycle paths. To accomplish this goal, clocks associated with multi-cycle paths (those paths having propagation times longer than the clock period) are identified and replaced. See Rezek, Col. 4, lines 26-37. Thus, the circuits of Rezek are not decomposed into ELBC components, nor does Rezek operate to partition ELBC components. Rezek teaches identification and modification of multicycle paths in circuits, which is a completely different concept. The elements of merging ELBCs, grouping ELBCs, forming ELBCs, and mapping ELBCs, as claimed by the Applicants in independent claims 1, 10, 14, 16-17, 21, 24, and 28, are also not disclosed by Rezek. Hollstein speaks to the tradeoffs involved, with design projects that include a mix of hardware and software components. "Partitioning", as described by Hollstein, means the allocation of various design functional elements between software and hardware. See Hollstein, parts 2 and 4.3. Thus, ELBCs, their use and manipulation, are also not described by Hollstein. Therefore, no combination of Rezek and Hollstein can be used to repair the deficiencies admitted in the Office Action, or to teach decomposition of circuits into ELBCs, partitioning of ELBCs, merging ELBCs, grouping ELBCs, forming ELBCs, and mapping ELBCs, as claimed by the Applicants in independent claims 1, 10, 14, 16-17, 21, 24, and 28.

The Examiner asserts that, as defined in Applicant's specification, an extended latch boundary component is a latch with an inverter (*Specification page 3*). The Examiner asserts that a latch with an inverter output is known in the digital logic art.

Finally, with respect to independent claim 18, the elements of "expanding the repeated circuit structure once to form an expanded circuit structure" and "grafting the expanded circuit structure" are not disclosed by either Rezek or Hollstein. Therefore, no combination of Rezek and Hollstein can provide these missing elements with respect to claim 18.

The Examiner asserts that the Applicant's arguments are persuasive in regards to the 35 U.S.C. 103(a) rejection of Independent Claim 18. The Examiner withdraws the 35 U.S.C. 103 rejection of Claim 18.

**Applicants argued:**

*There Is No Reasonable Expectation of Success.* Combining Rezek and Hollstein does not achieve or advance the goals of either system. Rezek is concerned with the identification and adaptation of multi-cycle paths for proper simulation results. Hollstein is concerned with reducing the cost of designs according to tradeoffs effected between hardware and software. Rezek does not mention the division of designs into hardware and software

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components; merely the use of modified clock signals in certain hardware designs to provide more accurate simulation results. Adding the partitioning capability of Hollstein does nothing to improve the clocking simulations described by Rezek. See Rezek, Col. 12, line 7 - Col. 13, line 5.

Similarly, Hollstein does not mention the; existence of multi-cycle clocks; merely the allocation of hardware and software elements within a system. Adding modified multi-cycle clocks (taught by Rezek) does nothing to enhance the process of simulated annealing disclosed by Hollstein. See Hollstein, part 4.3.

Finally, neither Rezek nor Hollstein mentions, describes, or teaches the use of ELBCs in any way. Therefore, combining Rezek and Hollstein does not convey a reasonable expectation of success in either case.

*There Is No Motivation to Combine the References.* As mentioned previously, the use and manipulation of ELBCs is not mentioned by either Rezek or Hollstein. However, it is asserted in the Office Action that "an ordinary artisan would have been motivated to search the behavioral simulation art in order to overcome the express deficiencies of the references in regards to a dice partitioning tool, to find methods to simulate multi-cycle paths in high performance systems," and that "it would have been obvious ... to have modified the boundary latch modeling and simulation methods of the Rezek et al. reference with the partitioning methods of the Hollstein et al. reference." The Applicants respectfully disagree.

The Examiner has found Applicant's arguments to be persuasive and withdraws the 35 U.S.C. 103(a) rejections of Claims 1, 10, 14, 16-17, 21, 24 and 28.

An updated search has revealed new art.

**Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Independent Claim 18 is rejected under 35 U.S.C. 102(b) as being anticipated by

**Beausang U.S. Patent 5,828,579.**

3.1 As regards independent **Claim 18** the *Beausang* reference teaches, a method of sharing a repeated circuit structure in a circuit model (**Figure 6A, Col. 6 Lines 43-67, Col. 7 Lines 1-34**), expanding the repeated circuit structure (**Figure 6B, Col. 6 Lines 43-67, Col. 7 Lines 1-34**); and grafting the expanded circuit structure to the circuit model (**Figure 7B, Col. 6 Lines 43-67, Col. 7 Lines 1-34**). The Examiner directs the Applicant to the term “*scan chain design database*”, as disclosed in the *Beausang* reference.

4. Independent **Claims 10, 16 and 17** is rejected under 35 U.S.C. 102(b) as being anticipated by **Beausang et al. U.S. Patent 5,903,466**.

4.1 As regards independent **Claims 10, 16 and 17** the *Beausang et al.* reference teaches, a latch boundary component (**Figure 13B Items 1050 and 1057**), a plurality of first nodes (**Figure 15A, note the plurality of input nodes on 1050 and 1051**), with a plurality of output latches, going to a plurality of input latches (**Figures 3B**).

**Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Independent **Claims 1 and 21** and dependent **Claim 2** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Beausang et al. U.S. Patent 5,903,466** (*hereafter referred to as Beausang-1*) in view of **Beausang et al. U.S. Patent 5,949,692** (*hereafter referred to as Beausang-2*).

5.1 As regards independent **Claims 1 and 21** the *Beausang-1* reference discloses preparing a circuit model for simulation (**Figures 3A, 12, Col. 8 Lines 47-67, Col. 9 Lines 1-22**), decomposing the circuit model having a number of latches into a plurality (**Figures 15A and 15B**), of extended latch boundary components (**Figure 13B, note, Applicant's specification defines, page 3, an Extended Latch Boundary Component as being a latch with an inverter output, note items 1050 and 1057 in Figure 13B and Figures 16A, 16B, 17A, 17B and 18A**).

However, the *Beausang-1* reference does not expressly disclose, partitioning the plurality of extended latch boundary components, *however, it is noted by the Examiner that the Beausang-1 reference does disclose the need for linking groups of scan cells into a design to be tested (Col. 3 Lines 10-16)*.

The *Beausang-1* reference does disclose that: *it is unclear under the prior art system when a designer can "sign off" on his or her work in the design process (Col. 4 Lines 13-17)*.

The Examiner notes, that even though there is a solution to the problem of long compile times for IC designs presented in the *Beausang-1* reference, an artisan of ordinary skill would have been motivated to find a better solution to decrease the amount of time required to compile a

design and to address the express deficiencies of the *Beausang-1* reference. In the Hierarchical scan architecture art the *Beausang-2* reference discloses partitioning the plurality of extended latch boundary components (**Figure 2A Item 310, Figures 6A-14B, Col. 26 Lines 50-67, Col. 27 Lines 1-17**).

Thus, it would have been obvious, to one of ordinary skill in the art, at the time the invention was made, to have combined the extended latch boundary components teachings of the *Beausang-1* reference with the partitioning methods of the *Beausang-2* reference because, the IC designer can now “sign off” his or her work at the completion of the module design and their completed and optimized modules do not need to be later disrupted (*Beausang-2 Col. 3 Lines 3-11*), thus reducing the amount of time required to qualify the design and increase productivity.

5.2 As regards dependent **Claim 2** the *Beausang-1* reference does not expressly disclose decomposing hierarchical cells into a plurality of extended latch boundary components.

The *Beausang-2* reference discloses decomposing hierarchical cells into a plurality of extended latch boundary components (**Figures 6A-14B**).

*For the motivation to combine the Beausang-1 reference with the Beausang-2 reference please see paragraph 3.1 above.*

6. Independent **Claim 14** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Beausang et al. U.S. Patent 5,903,466** (*hereafter referred to as Beausang-1*) in view of **Beausang et al. U.S. Patent 5,828,579** (*hereafter referred to as Beausang-3*).

6.1 As regards Independent **Claim 14** the *Beausang-1* reference discloses preparing a circuit model for simulation (**Figures 3A, 12, Col. 8 Lines 47-67, Col. 9 Lines 1-22**), having a total simulation time (**Col. 4 Lines 6-9**).



However, the *Beausang-1* reference does not expressly disclose grouping the plurality of extended latch boundary components into a plurality of partitions, *although the Beausang-1 reference does disclose extended latch boundary components, (Figure 13B, note, Applicant's specification defines, page 3, an Extended Latch Boundary Component as being a latch with an inverter output, note items 1050 and 1057 in Figure 13B and Figures 16A, 16B, 17A, 17B and 18A), and reducing the communication time within the plurality of partitions by adjusting the grouping.*

The *Beausang-1* reference does disclose that: it is unclear under the prior art system when a designer can "sign off" on his or her work in the design process (Col. 4 Lines 13-17).

The Examiner notes, that even though there is a solution to the problem of long compile times for IC designs presented in the *Beausang-1* reference, an artisan of ordinary skill would have been motivated to find a better solution to decrease the amount of time required to compile a design and to address the express deficiencies of the *Beausang-1* reference. In the Hierarchical scan architecture art the *Beausang-3* reference discloses partitioning the plurality of extended latch boundary components (**Col. 12 Lines 51-55**) as well as grouping a plurality of partitions (**Col. 12 Lines 45-48**), as well as methods of adjusting the grouping (**Col. 13 Lines 9-15, Col. 37 Lines 20-67, Col. 38, Col. 39 Lines 1-36, Figures 12A-14B**).

Thus, it would have been obvious, to one of ordinary skill in the art, at the time the invention was made, to have combined the boundary scan teachings of the *Beausang-1* reference with the scan resource grouping teachings of the *Beausang-3* reference because, the module designer will no be able to "sign off" his or her work at the completion of the module design

(*Beausang-3 Col. 3 Lines 7-12*), which will decrease the amount of communication time required for the modules in each of the groupings (*Beasang-3 Col. 3 Lines 51-57*).

**Allowable Subject Matter**

5. The following is an Examiner's reasons for allowance: Independent **Claim 24** is allowable over the prior art of record. The combination of a *dicing unit* in combination with the partitioning of a plurality of *extended boundary latch boundary components*, including a *simulation unit coupled to the dicing unit*, is a non-obvious modification over the prior art of record.

5.1 Independent **Claim 28** is allowable over the prior art of record. The limitation, in combination with other limitations of, *finding each cell in the plurality of cells that is highest in the hierarchy such that a single extended latch boundary component satisfying a given size constraint can be mapped into a cell*, is not disclosed nor made obvious by the prior art of record.

5.2 Dependent **Claims 25-27** are allowed as they depend upon an allowed base claim.

5.3 Dependent **Claims 3-9, 11-13, 15, 19, 20, 22 and 23** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

**Conclusion**

6. An updated search has revealed new art. New Art rejections have been applied to independent **Claims 1, 10, 14, 16-18 and 21** and dependent **Claim 2**. Dependent **Claims 3-9, 11-**

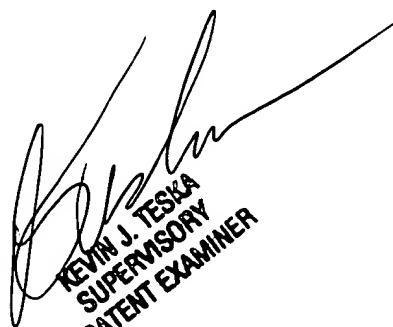
13, 15, 19, 20, 22 and 23 have been objected to, Claims 24-28 have been allowed over the prior art of record. This action is made **NON-FINAL**.

6.1 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dwin M Craig whose telephone number is 703 305-7150. The examiner can normally be reached on 10:00 - 6:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Teska can be reached on 703 305-9704. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DMC



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